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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,228	11/28/2003	Gregory K. Otten	22.3089	1227

26932 7590 06/29/2005

JEFFREY E. DALY
GRANT PRIDECO, L.P.
400 N. SAM HOUSTON PARKWAY EAST
SUITE 900
HOUSTON, TX 77060

EXAMINER

HEWITT, JAMES M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/707,228		OTTEN, GREGORY K.	
	Examiner		Art Unit	
James M Hewitt		3679		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003 and 11 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

Claims 26, 49, 51, 55 and 63-81 are objected to because of the following informalities:

In claim 26 line 3, "at" should be deleted.

In claim 49 line 2, as there are two box connectors (one on said first section of pipe and the mating box connector) recited in claim 34, from which claim 49 depends, it is unclear as to whether the phrase "said pin and box connectors" is to reference the box connector on said first section of pipe or both box connectors. The claim should be amended to address this.

In claim 51 line 4, "said interior sealing surface" lacks antecedent basis. To correct this, it is suggested that "internal sealing surface" as recited in line 17 of claim 50 should be replaced with "interior sealing surface".

In claim 55 line 2, the phrase "on said first section of pipe" should be inserted after "connector" for clarity.

In claim 63 line 2, as there are two box connectors (one on said first section of pipe and the mating box connector) recited in claim 50, from which claim 63 depends, it is unclear as to whether the phrase "said pin and box connectors" is to reference the box connector on said first section of pipe or both box connectors. The claim should be amended to address this.

In claim 64 line 10, the phrase "said threaded connector" should be replaced with "said coupled one of said threaded connectors" for clarity.

In claim 65 line 5, "coupled" should be inserted between "said" and "connector".

In claim 75 line 2, the phrase "on said pipe section" should be inserted after "connectors" for clarity.

In claim 76 lines 1-2, the phrase "step of welding creates a" can and should be deleted.

Art Unit: 3679

In claim 76 line 2, "that" should be deleted.

In claim 76 line 3, the phrase "said threaded connector" should be replaced with "said coupled one of said threaded connectors" for clarity.

Claims 80 and 81 each should depend from claim 64 and not from claim 50.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 7-10, 14-18, 34-36, 42-43, 46-49, 64-66, 70-72, 76 and 78-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Hosoya et al (US 2004/0195836).

With particular reference to Figure 1, Hosoya et al disclose a first section of pipe (2) having a threaded pin connector that is threadedly connected to a second section of pipe (3) having a threaded box connector. External to the threaded joint is a circumferential recess (8) that is formed by the end of the box connector and a shoulder of the pin connector, and which has disposed therein a welding material (9). Internal to the threaded joint is another circumferential recess (6) that is formed by the end of the

pin connector and a shoulder of the box connector. The end of the pin connector includes an external surface which is in sealing engagement (via an interference fit) with an internal surface of the box connector adjacent the shoulder of the box.

Regarding claims 16-17, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, the limitations set forth in claims 16 and 17 have not been given patentable weight.

Regarding claim 34, it should be understood that the opposite end of pipe section (2) may have a box connector like the box connector on pipe section (3), and likewise the opposite end of pipe section (3) may have a pin connector like the pin connector on pipe section (2).

Regarding claims 47-48, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, the limitations set forth in claims 47 and 48 have not been given patentable weight.

Regarding claim 64, note that Hosoya et al's device is considered to be part of a pipeline comprised of sections of pipe having threaded connectors on each end as is known and should be understood.

Regarding claims 70 and 79, Hosoya et al's weld joint can be filled in a single weld pass.

Regarding claims 71 and 72, it should be understood that Hosoya et al's pipe sections (2, 3) are part of a pipeline and may have box or pin connectors on each end.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 11, 12, 39, 44, 45, 74, 77 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoya et al (US 2004/0195836).

Regarding claims 4, 39 and 74, Hosoya et al discloses that his threads are of parallel or tapered shape, which may or may not be considered to be inclusive of wedged dovetail threads with a continuously varying flank-to-flank width. In the instance that Hosoya et al is not considered to disclose the claimed thread type, it would have been obvious to one having ordinary skill in the art to employ wedged dovetail threads with a continuously varying flank-to-flank width as an alternative thread type and/or in order to meet given design requirements for the given application.

Regarding claims 11, 41 and 81, Hosoya et al discloses all the limitations set forth in these claims except for the claimed range for the relative depth of the weld joint. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the claimed range for the depth of the weld joint relative to the thickness of a pipe section, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Regarding claims 12, 45 and 77, it is unclear whether Hosoya et al's weld joint is a J-groove weld joint. However, given that J-groove weld joint are known and commonly employed, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a J-groove weld joint in Hosoya et al.

Claims 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoya et al (US 2004/0195836) in view of Applicant's Admitted Prior Art.

With respect to claim 67, in paragraph [0005], Applicant discloses that the "J-lay" technique is known. And as Hosoya et al's device is considered applicable to subsea pipeline, it would have been obvious to one having ordinary skill in the art to employ such a technique to form Hosoya et al's pipeline in order to allow laying of the pipeline in deep water without stressing the pipeline material excessively.

With respect to claims 68-69, in paragraph [0036], Applicant discloses that employing a top drive and power tong to rotate and couple a pipe section to a pipeline is known, it would have been obvious to one having ordinary skill in the art to employ a top drive and power tong to rotate and couple a pipe section to a pipeline in order to efficiently and reliably connect sections of pipe.

Claims 2-3, 5-6, 19-33, 50-63, 73 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoya et al (US 2004/0195836) in view of Huntsinger (US 3,080,179).

Hosoya et al fails to teach that his first and second sections of pipe comprise a plurality of lengths of adjacent pipe that are butt-welded to one another, and that his pin and box connectors are also butt-welded to his first and second sections of pipe. Huntsinger discloses a drill string comprising sections of pipe that are butt-welded to one another and wherein the pin and box connectors are coupled to sections of pipe via butt welds. In view of Huntsinger's teaching, it would have been obvious to one having ordinary skill in the art at the time the invention was made to butt-weld adjacent pipe sections of Hosoya et al in order to form a durable and reliable drill string or pipeline and to butt-weld his pin and box connectors to adjacent sections of pipe in order to enhance strength and stability.

Regarding claims 20 and 53, Hosoya et al discloses that his threads are of parallel or tapered shape, which may or may not be considered to be inclusive of wedged dovetail threads with a continuously varying flank-to-flank width. In the instance that Hosoya et al is not considered to disclose the claimed thread type, it would have been obvious to one having ordinary skill in the art to employ wedged dovetail threads with a continuously varying flank-to-flank width as an alternative thread type and/or in order to meet given design requirements for the given application.

Regarding claims 26 and 58, Hosoya et al discloses all the limitations set forth in these claims except for the claimed range for the relative depth of the weld joint. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the claimed range for the depth of the weld joint relative to the thickness of a pipe section, since it has been held that where the general conditions of a

Art Unit: 3679

claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Regarding claims 27 and 59, it is unclear whether Hosoya et al's weld joint is a J-groove weld joint. However, given that J-groove weld joint are known and commonly employed, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a J-groove weld joint in Hosoya et al.

Regarding claims 31-32 and 61-62, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, the limitations set forth in claims 31 and 32 have not been given patentable weight.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M Hewitt whose telephone number is 571-272-7084.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3679

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JAMES M. HEWITT
PRIMARY EXAMINER